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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,235	08/09/2005	Partho Sarkar	59652-5001	1623
24574	7590	01/30/2008		
JEFFER, MANGELS, BUTLER & MARMARO, LLP 1900 AVENUE OF THE STARS, 7TH FLOOR LOS ANGELES, CA 90067			EXAMINER KALAFUT, STEPHEN J	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 01/30/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/522,235

Applicant(s)

SARKAR ET AL.

Examiner

Stephen J. Kalafut

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 25 Jan 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 37-49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,893,762 in view of Visco *et al.* (US 6,605,316 or WO 01/09968), cited by applicants. The metallic porous support layer being both strong enough to support the functional layer assembly and porous enough to allow a reactant to flow therethrough would be implied by or obvious over the features recited in the claims of the '672 patent. For example, patented claim 1 recites "the dimensions of the support layer being selected to enable the support layer to mechanically support the functional layer assembly", which would imply that the dimensions would enable the support to be strong enough to provide the supporting function. Since the functional layers are in "concentric adjacent contact with the support layer", and since the support layer is "tubular" and a "substantially

metallic porous" layer, the pores would need to convey one of the reactants to the functional layer in adjacent contact therewith. Patented claim 2 recites a wall thickness of 65 microns or less, within the range of present claim 38, which is at most 80 microns. Patented claim 5 recites yttria-stabilized zirconia and  $Gd_2O$  doped  $CeO_2$  as electrolyte materials. Patented claim 8 recites cobalt oxide, iron oxide and copper oxide as sintering aids. Patented claims 18 and 24 recite methods of making fuel cells, including steps of depositing the functional layers, depositing a layer that is layer combusted, and sintering the deposited layers. Patented claims 21, 25 and 25 recite electrophoretic deposition as the step used to deposit some of the layers. The present claims differ from the patented claims by reciting that the electrodes are ceramic or cermet, and that the electrolyte is ceramic. Visco *et al.* disclose a solid electrolyte fuel cell with a ceramic electrolyte (US '316, column 10, lines 37-51; WO '968, page 14, line 35 through page 15, line 7), one cermet electrode (US '316, column 5, lines 6-11; WO '968, page 7, lines 24-28) and one ceramic electrode (US '316, column 7, lines 46-48; WO '968, page 11, lines 4-6). Because the materials of Visco *et al.* are used in solid oxide fuel cells (US '316, column 6, lines 20-22; WO '968, page 9, lines 9-11), which is the type of fuel cell recited in the claims of the '672 patent, it would be obvious to make the fuel cell of the claims of the '672 patent out of the materials disclosed by Visco *et al.*

The disclosure is objected to because of the following informalities: The specification does not refer to the US applications from which the PCT priority document is derived. Appropriate correction is required.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sarkar (US 6,846,588) and Sarkar *et al.* (US 6,824,907, US 6,936,367 and US 7,235,321) and are patents related to the present application. The PCT citations indicated as "X" or "Y" are noted, but are cited against claims which are no longer present. The document WO 01/86030 is indicated as corresponding to three US Pre-Grant Publications, which are now patented as the '907, '588 and '367 documents stated immediately above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Kalafut whose telephone number is 571-272-1286. The examiner can normally be reached on Mon-Fri 8:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 **STEPHEN KALAFUT  
PRIMARY EXAMINER  
GROUP** 1200